

REMARKS

I. Status of Claims

Claims 1-63 are currently pending. The claims are not amended herein.

II. Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-63 as unpatentable over U.S. Patent No. 6,403,704 to Bara ("the '704 patent"), U.S. Patent No. 6,689,345 to Jager Lezer ("the '345 patent"), U.S. Patent No. 6,565,862 to Bara ("the '862 patent"), and U.S. Patent No. 6,184,277 to Bara ("the '277 patent").¹ See Office Action at 3-5. Applicants respectfully traverse these rejections for at least the following reasons.

In order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner is instructed by the MPEP to make a "clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP § 2141 (rev. 6, Sept. 2007). The Supreme Court, in its recent decision in *KSR Int'l Co. v. Teleflex*, further instructs that the analysis supporting a rejection under 35 U.S.C. § 103 "should be made explicit." 127 S.Ct. at 1741, 82 U.S.P.Q.2d at 1396 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal

¹ The Examiner listed U.S. Patent No. 7,094,842 in the 103 rejection heading on page 3 of the Office Action; however, Applicants note that the Examiner also stated on page 5 of the Office Action that the 103 rejection in view of the '842 patent has been overcome. Thus, Applicants do not address the '842 patent herein. Applicants respectfully request clarification if their understanding of the rejection is incorrect.

conclusion of obviousness"). Applicants assert that these criteria have not been met here for at least the following reasons.

The '704, '862, and '345 patents

The Examiner argues that while the '704, '862, and '345 patents do not teach the claimed ratios of organopolysiloxane to particulate phase (see, e.g., claim 1), these patents "teach the claimed components...for the same purpose" and "[t]he amounts of individual components described in the prior art overlap with that of the instant claims. Thus the scope and content of the cited prior art is the same as that of the instant invention and hence preparing a cosmetic composition [as claimed] . . . by optimizing the amounts of the individual components (thus varying their ratios) would have been within the scope of a skilled artisan." Office Action at 3-4. Applicants respectfully disagree.

Specifically, as discussed in the instant specification at pages 1-2, paragraph [007]:

The inventors have found, unexpectedly, that the use of a binder comprising water and particles of an at least partially crosslinked elastomeric solid organopolysiloxane makes it possible to obtain a composition with a novel texture, from pasty to pulverulent, which exhibits excellent cosmetic properties, for example, in terms of freshness. Furthermore, such compositions can be advantageously shaped by pressing in a customary cosmetic container.

As discussed in the specification and previously on the record, the present invention relates to compositions having a "pasty to pulverulent texture," which is imparted by the claimed ratio of organopolysiloxane to particulate phase. None of the

'704, '862, and '345 patents teach or suggest the desirability of a composition having such a pasty to pulverulent texture, much less the organopolysiloxane to particulate phase required to achieve such a texture. Without any specific guidance from these references, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '704, '862, and '345 patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention, as alleged by the Examiner. Applicants reiterate that the Examiner has not given any explicit reason why one of ordinary skill in the art would have been motivated, either by the cited art or by knowledge generally available to the skilled artisan, to modify the composition of any of the '704, '862, and '345 patents by incorporating therein the organopolysiloxane and particulate phase in amounts sufficient to arrive at the claimed ratio (i.e., ranging from 0.4:1 to 1.8:1 as recited in e.g., claim 1). Thus, the Examiner has not met his burden in establishing a *prima facie* case of obviousness based on these patents. Accordingly, for at least this reason, the rejections over the '704, '862, or '345 patent are improper and Applicants respectfully request that these rejections be withdrawn.

Moreover, in further support of their non-obviousness position, Applicants submit below calculations showing the organopolysiloxane/particulate phase ratios taught by the relevant examples (i.e., examples disclosing compositions comprising an organopolysiloxane suspended in an aqueous phase and a particulate phase) of the '704, '862, and '345 patents:

U.S. Patent No. 6,403,704 -- Examples 2 and 3

Example 2: Foundation

Trefil BY 29-122 ²	70%
Pigments	7%
Talc	10%
Glycerin	5%
Preservatives	qs
Water	qs 100

² Contains 63 wt% organopolysiloxane

$$\begin{aligned}\text{Amount of organopolysiloxane} &= (70\%)(0.63) = 44.10\% \\ \text{Amount of particulate phase} &= 7\% \text{ pigments} + 10\% \text{ talc} = 17\% \\ \text{Ratio} &= 44.10/17 = 2.59\end{aligned}$$

Example 3: Eye Shadow

Trefil BY 29-122 ²	32%
Carbopol 980	0.58%
TEA	0.58%
Brown nacre	5%
Talc	5%
Preserving agent	0.75%
Water	qs 100

² Contains 63 wt% organopolysiloxane

$$\begin{aligned}\text{Amount of organopolysiloxane} &= (32\%)(0.63) = 20.16\% \\ \text{Amount of particulate phase} &= 5\% \text{ nacre} + 5\% \text{ talc} = 10\% \\ \text{Ratio} &= 20.16/10 = 2.02\end{aligned}$$

U.S. Patent No. 6,565,862 -- Example 2: Foundation

Trefil BY 29-122 ²	70%
Pigments	7%
Talc	10%
Glycerol	5%
Preservatives	qs
Water	qs 100

² Contains 63 wt% organopolysiloxane

Amount of organopolysiloxane = (70%)(0.63) = 44.10%
Amount of particulate phase = 7% pigments + 10% talc = 17%
Ratio = 44.10/17 = 2.59

U.S. Patent No. 6,689,345 -- Examples 1 and 2

Example 1: Foundation

Oily phase

Cyclopentasiloxane	10%
KSG-21 ³	20.4%
Pigments	10%

³ While KSG-21 is an organopolysiloxane, it is present in the oily phase of this composition; thus, it is not included in the ratio calculations below.

Aqueous phase

Trefil BY 29-119 ¹	5%
Xanthan	0.3%
Polyamide fibers	2.5t%
Propylene glycol	4 %
Preserving agents	qs
Water	qs 100

¹ Contains 63 wt% organopolysiloxane

Amount of organopolysiloxane = (5%)(0.63) = 3.15%
Amount of particulate phase = 10% pigments + 2.5% fibers = 12.5%
Ratio = 3.15/12.5 = 0.25

Example 2: Tinted Body Gel

Trefil BY 29-119 ¹	32%
Carbomer 980	0.6%
Triethanolamine	0.6%
Polyamide fibers	1%
Propylene glycol	1.8%
Pigments	5%
Preserving agents	qs
Water	qs 100

Contains 63 wt% organopolysiloxane

$$\begin{aligned}\text{Amount of organopolysiloxane} &= (32\%)(0.63) = 20.16\% \\ \text{Amount of particulate phase} &= 5\% \text{ pigments} + 1\% \text{ fibers} = 6\% \\ \text{Ratio} &= 20.16/6 = 3.36\end{aligned}$$

As shown above, none of the relevant examples of the '704, '862, and '345 patents teach the presently claimed organopolysiloxane/particulate phase ratio (i.e., ranging from 0.4:1 to 1.8:1 as recited in, e.g., present claim 1). Thus, the '704, '682, and '345 patents clearly do not teach the presently claimed ratios and, moreover, teach away from such ratios. As such, it cannot be said that the disclosures of these patents would motivate one skilled in the art to "optimize" the compositions of the patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention. For at least this additional reason, the rejections over the '704, '862, and '345 patents are improper and Applicants respectfully request that these rejections be withdrawn.

The '277 patent

The '277 patent teaches oil-based gel compositions (see col. 1, lines 20-22) comprising at least one organopolysiloxane combined with a fatty phase. See abstract. The '277 patent does not teach or suggest compositions comprising an aqueous

suspension of organopolysiloxane particles. However, the Examiner takes the position that the '277 patent does teach organopolysiloxane in an aqueous phase because it "teaches [the] addition of gelling agents in an aqueous phase (col. 4), which is exemplified as [a] gelled dispersion composition for skin care." Applicants respectfully disagree.

While the '277 patent does mention that the composition may include an optional aqueous phase, it nowhere mentions or suggests incorporating an organopolysiloxane into such phase. Indeed, to the contrary, the '277 patent teaches that the organopolysiloxanes are used to gel the fatty phase, and are generally conveyed in at least one hydrocarbon oil and/or a silicone oil. See col. 2, ll. 34-47. Thus, for at least this reason, the rejection is improper and should be withdrawn.

Furthermore, as argued previously, the '277 patent is completely silent with respect to the claimed ratio of organopolysiloxane to particulate phase. Moreover, because the '277 patent is directed to gel compositions, one skilled in the art would not be motivated to modify these composition by incorporating a particulate phase in an amount suitable to produce a composition having a pasty to pulverulent texture, as described in the instant application. Therefore, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

III. Obviousness-Type Double Patenting Rejections

Claims 1-63 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,565,862

to Bara ("the '862 patent") and claims 1-63 of U.S. Patent No. 6,689,345 to Jager Lezer ("the '345 patent").² See Office Action at 2-3.

The '345 patent

The Examiner concedes that the '345 patent does not teach the ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to optimize the compositions of the '345 patent to achieve the present invention. See *id.* Applicants respectfully traverse the rejection for at least the following reasons.

According to MPEP § 804 II.B.1., an obviousness-type double patenting rejection employs similar guidelines to those used for a statutory obviousness rejection under 35 U.S.C. § 103, except that only the claims themselves are analyzed and the disclosure of the cited patent or application may not be used as the basis of the rejection. Because the '345 patent was filed before the instant application was filed, the "one-way" test of obviousness is used to determine "whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim" in the '862 patent. See MPEP § 804 II.B.1.(a) (*citing In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that claims 1-63 of this application are not obvious over claims 1-63 of the '345 patent.

Specifically, under the one-way test for obviousness of *Berg*, to make a proper obviousness-type double patenting rejection, the Office must show that the presently

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claimed invention is an obvious variation of the invention claimed in the '345 patent. To establish a *prima facie* case of obviousness, the Office must show that the claims of the '345 patent teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would have been led to modify the prior art to arrive at the presently claimed invention. See MPEP §§ 2143 and 804 II.B.1. Applicants assert that the Office has failed to satisfy these requirements here.

The Examiner admits that the claims of the '345 patent do not teach or suggest all of the limitations of the rejected claims, specifically, the ratios recited in the rejected claims. Applicants assert that the disclosure of the '345 patent would not lead one skilled in the art to modify its compositions to arrive at the presently claimed invention. Specifically, as discussed above, the present invention relates to compositions having a pasty to pulverulent texture, which is imparted by the claimed ratio of organopolysiloxane to particulate phase, whereas the '345 patent provides no guidance with respect to the desirability of a composition of this texture nor the organopolysiloxane to particulate phase ratio required to achieve such a texture. The Examiner has failed to provide any reason why the skilled artisan, without any guidance from the '345 patent, would modify the composition of the '345 patent to arrive at the presently claimed composition. Thus, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '345 patent to achieve the present invention, as alleged by the Examiner. Accordingly, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

The '862 patent

Although Applicants do not agree with the rejection over the '862 patent, solely in an effort to expedite allowance of this application, Applicant submits herewith a Terminal Disclaimer directed to the '862 patent. As such, Applicant asserts that this rejection has been obviated and request that it be withdrawn.

IV. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims. Applicants' undersigned representative invites the Examiner to contact her at 404-653-6455, if a telephone interview would advance prosecution of this case.

If there is any fee due in connection with the filing of this Amendment and Reply, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



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By: _____

Erica C. Boughner
Reg. No. 60,694